

Remarks

Claims 1, 2, 8, 19, 26-37, and 42-46 were rejected as being anticipated by U.S. Patent No. 5,146,923 (Dhawan). Claim 1, as amended, describes an imaging head capable of producing one or more images of optically formed sections of the stressed skin tissue from light returned from focused light under the surface of the skin tissue. Dhawan describes a nevoscope which uses a still or video camera (9) to record images of tissue (see column 7, lines 8-10). A still or video camera cannot provide an image of a section through tissue from light returned from focused light under the tissue surface, but rather provides an image of the tissue surface, or an image of a volume of tissue transilluminated from the surface to a depth. At best, Dhawan described 3-D digital image by computer tomography at the top paragraph of column 3, and a computer-reconstructed cross-section of tissue at column 5 (see especially, column 5, lines 11-16 and 53-57). If Dhawan was capable of providing images of optically formed sections, why would it describe use of computer reconstruction to generate an image of a cross-section? Clearly, Dhawan is not capable of providing images of optically formed sections. Therefore, Claim 1 and any dependent claims thereupon are not anticipated by Dhawan.

Claim 26 describes imaging stressed tissue from light returned from a scanned focal spot through the tissue to provide an image of a section. Dhawan describes a nevoscope having a still or video camera (9) which does not operate by scanning a focal spot through tissue. Dhawan at best can image a tissue surface, or an image of a volume of tissue transilluminated from the surface to a depth. It is submitted that Dhawan requires computer reconstruction to obtain a cross-sectional image due to the fact that it is volume based imaging. Thus, Claim 26 and any dependent claims thereupon are not anticipated by Dhawan.

With respect to Claim 19, Dhawan shows no optical elements for confocal imaging, but only a still or video camera. Still or digital cameras cannot enable confocal imaging which optically sections tissue. Thus, Claim 19 cannot be anticipated by Dhawan.

For reasons argued with respect to Claim 1, amended Claims 35 and 43 and their respective dependent Claims 36-37 and 44-46 are also not anticipated by Dhawan. Withdrawal of the rejection of Claims 1, 2, 8, 19, 26-37, and 42-46 is respectfully requested.

Claims 3, 20, and 23 were rejected as being unpatentable over Dhawan in view of the Jester et al. article "In Vivo, Real-time Control Imaging" in the Journal of Electron Microscopy Techniques, Vol. 18, No. 1 (1991). With respect to Dhawan, Claim 3 depends on base Claim 1,

which for reasons argued earlier is patentable over Dhawan. Also, Dhawan fails to show the first and second moving means of Claim 20, and the translating means of Claim 23. One skilled in the art would not combine Dhawan and Jester et al. Dhawan relates to a handheld portable nevoscope which receives a raised tissue specimen in its inverted cup housing (44) (see Abstract, FIG. 1, and column 7, lines 54-55 of Dhawan). Connecting the Dhawan nevoscope to the x,y,z table of Jester et al. (see FIG. 2 of Jester et al.) would obviate Dhawan both being handheld and portable (see, Abstract lines 2-3 of Dhawan). Moreover, no need is present for a x,y,z table in Dhawan since a specimen in Dhawan's nevoscope is positionally oriented in the nevoscope by virtue of the specimen's placement in the inverted cup housing (44), as clearly evident by FIG. 1 of Dhawan. Therefore, Dhawan already provides by its design proper alignment to tissue and thus no motivation for adding alignment by an x,y,z table of Jester et al. is present, especially where it prevents Dhawan from being portable as taught by Dhawan. One skilled in the art would not add an element which obviates the teaching of a design. Moreover, Jester et al. fails to show the platen of Claims 3, 20 and 23 having an orifice for stabilizing tissue. Thus, Claims 3, 20 and 23 are believed patentable over Dhawan and Jester et al., either alone or in combination, and withdrawal of their rejection is requested.

Claim 6 was rejected as being unpatentable over Dhawan. Claim 6 depends on base Claim 1, which for reasons argued earlier is patentable over Dhawan. Dhawan further lacks the Claim 6 means for translating an imaging head in the claimed integrated assembly of Claim 1. It is the Examiner's position that "Dhawan discloses means for moving the imaging head with respect to the orifice in that the camera can be inserted into the device" (page 3, lines 21-23, of the Office Action of September 23, 2003). Mere insertion of a video or still camera (9) in an eyepiece (10) of Dhawan is not comparable to translating an imaging head. Dhawan does not describe or suggest any movement of its camera (9) once inserted in the opening of housing (22). Nevertheless, such movement is not obvious where FIG. 1 of Dhawan shows the end of camera (8) of a dimension fitting the opening of housing (28) at lens (12). If it is the Examiner's position that the camera's insertion represents the translation means of Claim 6, then it necessarily occurs when camera (9) is not integrated with housing (28). As a result, when the Examiner contended translation takes place not all of base Claim 1 limitations are met at that time since Dhawan cannot be considered as having the claimed integrated assembly between its camera (9) and housing (28). Clearly, one cannot take a position with a dependent claim which

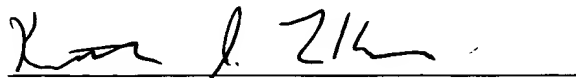
conflicts with a previous position taken with the base claim. Thus, Applicant requests that the rejection of Claim 6 be withdrawn.

Claims 21 and 22 are allowable but objected to as being dependent on rejected claims. Applicants believe that dependent Claims 21 and 22 are allowable along with their base Claim 20.

A petition for a one-month extension of time is enclosed with a check for the required \$55.00 petition fee.

Respectfully submitted,

Dated: August 27, 2004



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Enclosures: Petition for Extension of Time with Check for \$55.00; and  
Certificate of First Class Mailing.